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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/548,892	04/13/2000	Thomas I. Insley	52942USA6A	7476

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EXAMINER

MARKHAM, WESLEY D

ART UNIT PAPER NUMBER

1762

DATE MAILED: 11/28/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/548,892

Applicant(s)

INSLEY ET AL.

Examiner

Wesley D Markham

Art Unit

1762

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 October 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 10/11/2001. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached Office Action.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: 5,6,8,12,13 and 18-21.Claim(s) rejected: 1-4,7,9-11,14-17 and 22.Claim(s) withdrawn from consideration: 23-24.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

DETAILED ACTION

Advisory Action

Acknowledgement is made of applicant's amendment B, filed as paper #9 on October 15, 2001, in which minor changes were made to the specification. Claims 1 – 24 are currently pending in U.S. application serial # 09/548,892. Claims 23 – 24 stand withdrawn from further consideration without traverse, as being drawn to a non-elected invention, for the reasons set forth in paragraph 1 of the previous Office Action. An advisory action follows.

Response to Arguments

1. Applicant's arguments filed on October 15, 2001, have been fully considered but they are not persuasive.
2. Regarding the IBM Technical Disclosure Bulletin, the applicant's arguments are as follows: (1) The IBM Technical Disclosure Bulletin does not disclose that the process produces an electret, and thus the examiner is relying on the principle of inherency to satisfy the electret limitation of the applicant's claims. In addition, the applicant notes that it is not sufficient that the missing limitation may possibly be present in the cited disclosure, and that inherency cannot be established by probabilities or possibilities or the mere fact that a certain thing may result from a given set of circumstances. In response, the examiner agrees that the IBM Technical Disclosure Bulletin does not explicitly teach that an electret is produced. However, the IBM Technical Disclosure Bulletin teaches all the recited steps of the applicant's method,

and thus the process would necessarily / inherently have produced an electret. The examiner is not relying on the fact that an electret may have been produced. On the contrary, the examiner has asserted that an electret would have necessarily been produced, and to this point there is no evidence on the record to the contrary. (2)

The IBM Technical Disclosure Bulletin only teaches that the solvent vapor "softens" the film, but does not disclose *condensing* a vapor onto a dielectric article to form a condensate thereon. Further, the applicant states that excess vapors are forced through a conduit into a condenser, and therefore the condensation occurs in the condenser, not on the dielectric article. In response, simply because there are excess vapors that are later condensed in the process of the IBM Technical Disclosure Bulletin does not preclude the "non-excess" vapors from condensing on the dielectric film. In order for the vapor to "soften" and develop the film as desired by the IBM Technical Disclosure Bulletin, the film is "developed by exposure to solvent vapor". In order to perform this softening and developing of the dielectric film, at least a portion of the vapor would have necessarily condensed on the film. This is further supported by the fact that the film is subsequently dried after exposure to the solvent vapors.

3. Regarding Sidles et al. (USPN 4,351,789), the applicant's arguments are as follows:
(1) It can only be speculated that an electret is formed by the process of Sidles et al., as Sidles et al. does not indicate that an electret is produced. In response, Sidles et al. teach all the recited steps of the applicant's method, and thus the process would necessarily / inherently have produced an electret. The examiner is not relying on

the fact that an electret may have been produced. On the contrary, the examiner has asserted that an electret would have necessarily been produced, and to this point there is no evidence on the record to the contrary. (2) Sidles et al. do not teach a condensing step. In response, Sidles et al. teach that a vaporized coating material (for example, steam) is fed into a mold cavity and produces "a film of liquid coating material on the surface of the relatively cool green tire blank..." (paragraph bridging Cols.4 – 5). This is a condensing step. (3) The condensing step of Sidles et al. is not performed in a controlled environment (i.e., an environment whose volume, pressure, temperature, or a combination thereof can be regulated and/or altered in a predetermined manner). In response, Sidles et al. teach that the vaporized coating material is fed into the mold cavity at least until the tire press is nearly "closed" (Col.5, lines 7 – 10). In closing the tire press, Sidles et al. are both regulating and altering the volume of the environment (i.e., the mold cavity), and thus the environment of Sidles et al. is a controlled environment. In addition, by introducing steam into the mold cavity having a relatively cool tire blank, Sidles et al. are altering the temperature of the environment, and thus the environment of Sidles et al. is a controlled environment. (4) Sidles et al. do not disclose the material of the tire, and therefore it cannot be ascertained whether Sidles et al. are molding a dielectric article. In response, Sidles et al. are molding a tire blank (Col.5, line 4). The blank can be rubber (Col.6, lines 51 – 54). The applicant's specification notes that dielectric articles may be made from materials such as rubber (pg.5, lines 28 – 29). Therefore, the tire blank of Sidles et al. is a "dielectric article".

4. Regarding the combination of Angadjivand et al. (USPN 5,496,507) and Pike et al. (USPN 5,759,926), the applicant's arguments are as follows: (1) Neither of the documents teach or suggest condensing a vapor onto a dielectric article to create an electret. However, the test of obviousness is not an express suggestion of the claimed invention in any or all references but rather what the references taken collectively would suggest to those of ordinary skill in the art presumed to be familiar with them (*In re Rosselet*, 146 USPQ 183). (2) The record is devoid of any teaching or suggestion for combining the teachings of Angadjivand et al. and Pike et al. In response and as stated previously, Angadjivand et al. teach spraying a mist of water droplets to contact a substrate, such as a microfiber web, and then drying the substrate. This method forms an electret. Pike et al. teach that a microfiber web can be thoroughly contacted with water by spraying the fibers with either hot water or steam (i.e., water vapor). Therefore, it would have been obvious to one of ordinary skill in the art to wet the dielectric article of Angadjivand et al. by condensing steam on the article instead of wetting the article with a fine mist of water droplets with the reasonable expectation of success and achieving similar results (i.e., thoroughly wetting the fiber web as taught by Pike et al. and desired by Angadjivand et al.).

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wesley D Markham whose telephone number is

(703) 308-7557. The examiner can normally be reached on Monday - Friday, 8:00 AM to 4:30 PM.

6. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.
7. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



WDM
November 14, 2001

Wesley D Markham
Examiner
Art Unit 1762



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